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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/471,146	06/06/1995	MAXIMILIAN GRASSBERGER	900-9523/CON	8226

7590 06/15/2004  
ROBERT S HONOR  
SANDOZ CORPORATION  
59 ROUTE 10  
E HANOVER, NJ 07936

EXAMINER

COOK, REBECCA

ART UNIT PAPER NUMBER

1614

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 23

Application Number: 08/471,146  
Filing Date: June 06, 1995  
Appellant(s): GRASSBERGER ET AL.

D. Gabrielle Brouillette  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed November 25, 2002.

**(1) *Real Party in Interest***

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A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The brief states at the bottom of page 4 that claims 29-48 stand or fall together.

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

4,411,893	Johnson et al	10-1983
4,556,645	Showalter et al	12-1985
4,871,723	Makino et al	10-1989

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EPA 0 184 162

Okuhara et al

6-2986

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over EPA, '893 (Johnson) and '654 (Showalter). EPA discloses the compounds of the instant compositions (page 32, compound A; page 88, Example 5, compound E; page 89, Example 6, compound D; page 95, Example 17, compound C; page 98, Example 21, compound B). EPA also discloses that the compounds have antimicrobial activity (page 1, lines 26-34) and that they can be used to treat infectious disease. EPA further discloses (page 76, lines 15-30) that the compounds can be used with a suitable carrier or excipient for external application, take the form of emulsion or suspension, be in a semisolid form and may contain perfume. EPA additionally discloses a single dosage of 0.5-500 mg (page 77, lines 3-7), which would include the instant 1-3%.

The instant compositions appear to differ over EPA in reciting that the composition can be a lotion, gel or cream. However, Showalter, (column 40, lines 33-39) discloses that topical preparations include creams, lotions and gels and that they "may be formulated by well known procedures. See for example Remington's Pharmaceutical Sciences, Chapter 43, 14<sup>th</sup> ed., 1970..." Additionally, Johnson (column

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3, line 56 through column 4, line 24) discloses that compositions for use on skin may be formulated in the conventional manner using pharmaceutically acceptable media such as gels, lotions and creams.

Appellants argue that EPA does not disclose a topical composition and that “[I]t is not the intention of EPA ‘162 to topically administer compounds to yield a local effect. (e.g. an effect on the skin.” This is not persuasive. EPA discloses that the compounds can be used for external application, be in a semisolid form and may contain perfume. Clearly, perfumes would not be administered orally or by injection to a patient. Perfumes would only be employed in a topical preparation.

Appellants argue that there is no motivation to combine EPA with Johnson and Showalter. This is not persuasive. EPA discloses that the compounds may be administered externally and Johnson and Showalter disclose that creams, lotions and gels are well known compositions for compounds useful for topical conditions. This would include the compounds disclosed by EPA to be useful as antimicrobials.

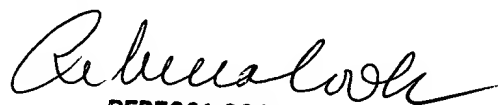
Appellants argue that Test 2 of EPA (page 70, line 1-page 71, line 14) deals with in vitro activity of the compounds of the instant compositions on the fungi aspergillus and fusarium. They further argue that “these organisms are typically treated systemically, not topically.” This is noted, but these organisms could be treated topically. Furthermore, the instant claims are directed to compositions and not to methods of treatment.

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Appellants' argument that the deliberate definition of Makino "externally applying to the skin" (abstract, lines 1-2) is evidence that "externally applying" contemplates applications other than to the skin is not persuasive, since Makino teaches skin.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



REBECCA COOK  
PRIMARY EXAMINER  
GROUP 1200 / L14

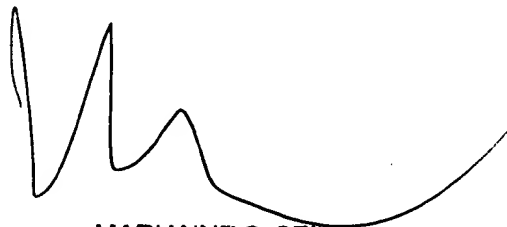
June 12, 2004

Conferees

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PHYLLIS SPIVACK  
PRIMARY EXAMINER

ROBERT S HONOR  
SANDOZ CORPORATION  
59 ROUTE 10  
E HANOVER, NJ 07936



MARIANNE C. SEIDEL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600